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Docket No.: SON-417  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent No. 5,453,758 of:  
Kazuhiro SATO

Issued: September 26, 1995

Application No.: 08/098,896

Filed: July 29, 1993

For: INPUT APPARATUS

**RECEIVED**

**JUL 17 2006**

**OFFICE OF PETITIONS**

**PETITION UNDER 37 C.F.R. §1.378(B) TO ACCEPT UNAVOIDABLY DELAYED  
PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**INTRODUCTORY COMMENTS**

Petitioner hereby petitions for the acceptance of the delayed 7 ½ year maintenance fee payment and for reinstatement of U.S. Patent No. 5,453,758. Accordingly, this Petition under 37 C.F.R. §1.378(b) is proper.

Pursuant to 37 C.F.R. §1.378(b), any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:

- (1) the required maintenance fee set forth in §1.20(e)-(g);
- (2) the surcharge set forth in § 1.20(i)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

**MAINTENANCE FEE (37 C.F.R. §1.20(e)-(g))**

For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond eight years; the fee is due by seven years and six months after the original grant by other than a small entity is \$2,300.00 (37 C.F.R. §1.20(f)).

Accordingly, the maintenance fee being submitted is \$2,300.00.

**SURCHARGE**

The surcharge required by 37 C.F.R. §1.20(i)(1) of \$700.00 must be paid as a condition of accepting unavoidably delayed payment of the maintenance fee.

Accordingly, the surcharge being submitted is \$700.00.

**MANNER OF PAYMENT**

The Director is hereby authorized to charge Deposit Account # 18-0013 the sum of \$3000.00. A duplicate copy of this authorization is attached.

**AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY**

The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account # 18-0013. A duplicate copy of this authorization is attached.

## **OVERPAYMENT**

As to any overpayment made, please credit to Deposit Account # 18-0013.

## **SHOWING**

Pursuant to 37 C.F.R. §1.378(b), any petition to accept an unavoidably delayed payment of a maintenance fee must include a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Pursuant to U.S. Patent and Trademark Office (USPTO) practices and procedures, evidence that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable. M.P.E.P. §2590.

Section 2590 of the M.P.E.P. further indicates that a general discussion of the "unavoidable" delay standard can be found within M.P.E.P. §711.03(c). Section 711.03(c) of the M.P.E.P. provides that:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may

properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

Also found within M.P.E.P. §711.03(c) is an indication of three periods to be considered by the USPTO during the evaluation of the instant Petition. These time periods include (A) the delay in reply that originally resulted in the expiration of the original patent; (B) the delay in filing the instant Petition; and (C) the delay in filing a grantable petition for the acceptance of the delayed 7 ½ year maintenance fee payment.

**(A) Original Delay** - During its evaluation of the Petition, the USPTO will generally consider the circumstances and reasons surrounding the original delay in paying the maintenance fee by to the due date of September 26, 2003, which resulted in the expiration of the original patent (U.S. Patent No. 5,453,758).

The above-identified application (U.S. Patent Application Serial No. 08/098,896) issued on September 26, 1995 as the original patent.

Upon the issuance of a patent, the original patent number and issue date of the original patent are entered into the database of the computerized docketing system for Rader, Fishman and Grauer (the Firm). Upon entry of the issue date, all post-issuance due dates for the life of the original patent are automatically generated by the docketing system. Those due dates include the dates for reissue deadlines, the expiration date of the patent, and the 3.5, 7.5, and 11.5 year maintenance fee due dates. The maintenance fee payments due are submitted by the Firm to the USPTO on or about the 1st and 15th of the month that the fee without surcharge is due.

For internal tracking purposes, the Firm assigned client matter number 80001-0881 to application serial number 08/098,896, which matured into the original patent. The Firm's docket sheet for the original patent printed on June 29, 2006 reveals that for RADER# 80001-0881, field M1 indicates payment of the first maintenance fee on March 12, 1999.

A copy of docket sheet for the original patent printed on June 29, 2006 is provided along with this Petition as ATTACHMENT A.

The website for the USPTO confirms payment of the 3 ½ year maintenance fee on March 12, 1999. Thus, the 3 ½ year maintenance fee in connection with the original patent had been paid by the Firm in March of 1999.

A copy of the Patent Bibliographic Data (Patent Number 5453758) is provided along with this Petition as ATTACHMENT B.

An e-mail dated January 10, 2003 from Sanae Takada at Sony Intellectual Property Solutions Corporation to Paula L. Talarek at the Firm indicates that responsibility for the applications identified on Sheet A of the attached document "DC107977 030109.XLS" will be transferred from the Firm to Computer Packages Inc. (CPA).

A copy of the e-mail dated January 10, 2003 in its redacted form is provided along with this Petition as ATTACHMENT C.

Document "DC107977 030109.XLS" attached to the e-mail dated January 10, 2003 lists as record 914 the reissue application (U.S. Patent Application Serial No. 08/736,288).

A copy of document "DC107977 030109.XLS in its redacted form is provided along with this Petition as ATTACHMENT D.

The Firm's docket sheet for the original patent printed on June 29, 2006 (ATTACHMENT A) shows a notation entered on February 24, 2003 indicating receipt of the client instructions that payment of the maintenance fees will be handled by CPA, and further shows that field M2 indicates no payment of the second maintenance fee by the Firm.

Dated April 16, 2003, a Maintenance Fee Reminder retrieved from the files located on-site at the Firm's Washington, D.C. office identifies the original patent. The Maintenance Fee Reminder includes a handwritten notation of "CPA".

A copy of the Maintenance Fee Reminder in its redacted form is provided along with this Petition as ATTACHMENT E.

"If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, *it may properly be said to be unavoidable*, all other conditions of promptness in its rectification being present" (emphasis added). *In re Egbers*, 6 USPQ2d 1869, 1871 (Comm'r Pat. 1988).

A copy of *In re Egbers* is provided along with this Petition as ATTACHMENT F.

Section 2590 of the M.P.E.P. provides an error in a docketing system could possibly result in a finding that a delay in payment was unavoidable if it were shown that reasonable care was exercised in designing and operating the system and that the patentee took reasonable steps to ensure that the patent was entered into the system to ensure timely payment of the maintenance fees.

A letter from Sanae Takada dated June 26, 2006 explains that an error in a docketing system resulted in the delayed in payment of the 7 ½ year maintenance fee, that reasonable care was exercised in designing and operating the system, and that the patentee took reasonable steps to ensure that the patent was entered into the system to ensure timely payment of the maintenance fees.

A copy of the letter from Sanae Takada dated June 26, 2006 is provided along with this Petition as ATTACHMENT G.

This situation is analogous to that provided within *In re Katrapat, AG*, 6 USPQ2d 1863 (Comm'r Pat. 1988).

A copy of *Katrapat* is provided along with this Petition as ATTACHMENT H.

Specifically, the letter from Sanae Takada dated June 26, 2006 identifies the use of a computerized docketing system to insure that responses are timely filed. Likewise, the records clerk of *Katrapat* entered the data from the hardcopy log into the computer once a month, and the computer generated dockets for individual patent attorneys (*id.*).

Katrapat's attorneys also used a computerized docketing system to insure that responses are timely filed (*Katrapat* at 1867).

As described within the letter from Sanae Takada dated June 26, 2006, an error in the docketing system was the cause of the delay in providing the 7 ½ year maintenance fee payment to the U.S. Patent and Trademark Office.

Within *Katrapat*, counsel did not prepare a timely response to an Office action that was never entered into the docketing system. (*id.*). But despite the presence of multiple errors made in providing a timely response (*Katrapat*, at 1867-68), the Commissioner nevertheless granted Katrapat's petition to revive the reexamination proceedings under the "unavoidability" standard. (*Katrapat*, at 1868).

The 7 ½ year maintenance fee in connection with the original patent was due to be paid by March 27, 2003, seven years and six months after the original patent issued. But as a result of a docketing error, the grace period for submitting the 7 ½ year maintenance fee ended on September 26, 2003 without a fee payment being made, and the original patent expired on September 26, 2003 for failure to pay the 7 ½ year maintenance fee.

Dated October 29, 2003, a Notice of Patent Expiration retrieved from the files located on-site at the Firm's Washington, D.C. office identifies the original patent.

A copy of the Notice of Patent Expiration in its redacted form is provided along with this Petition as ATTACHMENT I.

**(B) Delay in filing the instant Petition** - A reissue application based upon the original patent has been filed on October 24, 1996 as U.S. Patent Application Serial No. 08/736,288.

Subsequent to September 26, 2003, a Docketing Notice from the Board of Patent Appeals and Interferences (The Board) having a date of November 5, 2003 was mailed in the reissue application.

Thereafter, a Notice of Hearing from The Board having a date of February 2, 2004 was mailed in the reissue application. An Oral Hearing was conducted on April 27, 2004, with a Decision on Appeal being mailed in the reissue application on April 30, 2004. The Decision on Appeal affirmed the rejection of claims 6, 10, 13-14, and 16-17 and reversed the rejection of claims 9 and 15.

On May 14, 2004, a Response to Decision on Appeal was filed. An Office Action as a reply to the Response to Decision on Appeal was mailed in the reissue application on November 23, 2004.

Amendment In Response to Non-Final Office Action was filed on January 24, 2005.

By May 24, 2005, the Firm had expected to receive from the USPTO a reply to the Amendment of January 24, 2005. Accordingly, on May 24, 2005, the Firm placed a telephone call to the USPTO for a status update. During that telephone call, Examiner Chow indicated that the reissue application was on his docket and ready for examination, and that there was nothing else for the Firm to do at that time.

In the absence of any additional response from the USPTO, the Firm placed another telephone call to the USPTO on September 9, 2005. During that telephone call, Examiner Chow indicated that the application had been placed in a condition of allowance on August 19, 2005 and that the application had been forwarded for review by a Special Programs Examiner (SPRE). The Firm, then, placed a telephone call with the SPRE on September 9, 2005, leaving a voicemail



message. During a telephone call of September 12, 2005, the Firm was advised by the USPTO that the reissue application was under review by Dwayne Boggs.

A copy of the telephone notes is provided along with this Petition as ATTACHMENT J.

About 1 ½ years after the filing of the Amendment of January 24, 2005 in the reissue application and almost three years after the original patent expired on September 26, 2003, an Order to Show Cause was mailed on May 31, 2006. The Order provided a period of 30 days to show why the proceedings in this reissue application should not be terminated because of a failure to pay the maintenance fee for the original patent.

A copy of the Order to Show Cause is provided along with this Petition as ATTACHMENT K.

By a letter of June 8, 2006, the Firm notified the patentee of the mailing of the Order to Show Cause.

A copy of the letter of June 8, 2006 from the Firm to the patentee is provided along with this Petition as ATTACHMENT L.

By a letter of June 9, 2006, the patentee instructed the Firm to seek a reinstatement of the original patent.

A copy of the letter of June 9, 2006 from the patentee to the Firm is provided along with this Petition as ATTACHMENT M.

By a letter of June 16, 2006, the Firm requested additional information from the patentee.

A copy of the letter of June 16, 2006 from the Firm to the patentee is provided along with this Petition as ATTACHMENT N.

As previously indicated hereinabove, a letter from Sanae Takada dated June 26, 2006 (ATTACHMENT G) has explained that an error in a docketing system resulted in the delayed in payment of the 7 ½ year maintenance fee, that reasonable care was exercised in designing and operating the system, and that the patentee took reasonable steps to ensure that the patent was entered into the system to ensure timely payment of the maintenance fees.

**(C) Delay in filing a grantable Petition** - It is respectfully believed that a grantable Petition is embodied in the instant Petition.

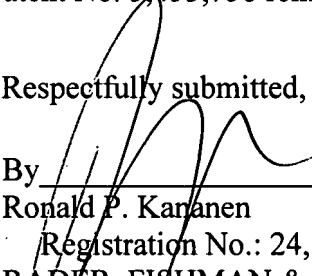
### **CONCLUSION**

As shown hereinabove, the delay in paying the 7 ½ year maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely, and since the delay resulted from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function.

Under the circumstances involved, and this petition to accept the unavoidably delayed payment of the maintenance fee and for reinstatement of patent had been promptly pursued and filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the original patent. Accordingly, the petitioner respectfully requests that the delayed payment of the 7 ½ year maintenance fee be accepted and U.S. Patent No. 5,453,758 reinstated.

Dated: June 30, 2006

Respectfully submitted,

By   
\_\_\_\_\_  
Ronald P. Karanen  
Registration No.: 24,104  
RADER, FISHMAN & GRAUER PLLC  
1233 20th Street, N.W.  
Suite 501  
Washington, DC 20036  
(202) 955-3750  
Attorney for Applicant

**AUTHORIZATION-DUPLICATE COPY**

**MANNER OF PAYMENT**

The Director is hereby authorized to charge Deposit Account # 18-0013 the sum of  
\$3000.00.

**AUTHORIZATION-DUPLICATE COPY**

**AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY**

The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account # 18-0013.

**AUTHORIZATION-DUPLICATE COPY**

**OVERPAYMENT**

As to any overpayment made, please credit to Deposit Account # 18-0013.

Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT A**

RADER# 80001-0881

PRINTED ON: 6/29/2006

COUNTRY	US	UNITED STATES	TITLE		PRIOR		
NEW/CON	NEW	SERIAL#	08/098,896	SON-417 INPUT APPARATUS	MAIL		
RELATED		PATENT#	5,453,758		FILE	7/29/1993	
TYPE	UTL	STATUS	ISSUED		PUBL		
CLIENT	80001	Sony Corporation	1	CREF	S93P0482US00	ISSUE	9/26/1995
AGENT				AREF		1ST	7/29/1993
						EXP	7/29/2013

ID	O	ACTION	BASE	DUE IN	DUE	EXTNS	FINAL	EXT	RESPONSE	CALL UP	1	2	P
M3	Y	3RD MAINT FEE DUE	9/26/1995										
M2	Y	2ND MAINT FEE DUE	9/26/1995										
M1	N	1ST MAINT FEE DUE	9/26/1995	42	M	3/26/1999	1	6	9/26/1999	0	3/12/1999	6	M
											Y	Y	Y

## FAMILY MEMBERS

REFERENCE#	COUNTRY	NEW/CON	SERIAL#	FILED	PATENT #	ISSUED	STATUS
80001-0881	UNITED STATES	NEW	08/098,896	7/29/1993	5,453,758	9/26/1995	ISSUED

USER-DEFINABLE FIELDS		PATENT FIELDS			
1		SMALL ENTITY	No	ART UNIT	
LOC		CLAIMS		EXAMINER	
PBL#		PUBLICATION#		CONFIRM#	

P07800US00 ENTERED 11/24/1997 MODIFIED 2/24/2003 BY LDD ATTORNEYS RPK / plt / plt

## NOTES

Rec clt instructions that maint fees will be handled by CPA.

Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT B**



Return To:



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Online  
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**United States  
Patent and  
Trademark Office**

<b>Patent Bibliographic Data</b>				<b>06/08/2006 02:52 PM</b>	
Patent Number:	5453758	Application Number:	08098896		
Issue Date:	09/26/1995	Filing Date:	07/29/1993		
Title:	INPUT APPARATUS				
Status:	Expired for non-payment on: 09/26/2003				
Window Opens:	09/26/2002	Surcharge Date:	03/27/2003	Entity:	Large
Fee Amt Due:	\$0.00	Surchg Amt Due:	\$0.00	Expiration:	09/26/2003
Fee Code:	Total Amt Due: \$0.00				
Surcharge Fee Code:					
Most recent events (up to 7):	Patent Expired for Failure to Pay Maintenance Fees. Maintenance Fee Reminder Mailed. Payor Number Assigned. Payment of Maintenance Fee, 4th Year, Large Entity. --- End of Maintenance History ---				
Address for fee purposes:	RONALD P. KANANEN RADER, FISHMAN & GRAUER 1233 20TH STREET, NW SUITE 501 WASHINGTON,, DC 20036				
NOTE: All USPTO fees are subject to change. If you are making a payment by mail or fax, please visit this link or contact the Maintenance Fee Branch (571-272-6500) to confirm the amount due on the date payment is to be made. A maintenance fee payment can be timely made using the certificate of mailing or transmission procedure set forth in 37 CFR 1.8.					
<div>Run Another Query</div>					

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Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT C**

**Brian K. Dutton**

---

**From:** Paula L. Talarek  
**Sent:** Thursday, June 29, 2006 5:10 PM  
**To:** Brian K. Dutton  
**Subject:** FW:

-----Original Message-----

**From:** Takada, Sanae [mailto:Sanae.Takada@jp.sony.com]  
**Sent:** Monday, November 01, 2004 10:49 PM  
**To:** Paula L. Talarek  
**Cc:** Ronald P. Kananen  
**Subject:**

Dear Paula-san,

On your request by your e-mail [REDACTED]

I am forwarding you my e-mail sent to you dated January 1, 2003.

If you need an up-to-date list of cases that have been transferred to CPI,  
please feel free to ask me.

If you have any other questions, please let me know.

Best Regards,

Sanae Takada

---

Sanae Takada  
Foreign Patent Affairs Group, Intellectual Property Control Dept.  
Sony Intellectual Property Solutions Corporation  
Gate City Osaka 1-11-1 Osaka, Shinagawa-ku, Tokyo, 141-0032 Japan  
Tel +81-3-5435-3910 Fax +81-3-5435-3043  
E-mail Sanae.Takada@jp.sony.com

---

\* From: Sanae Takada <Sanae.Takada@jp.sony.com> \*  
Date: Fri, 10 Jan 2003 16:31:34 +0900  
To: "Paula L. Talarek" <plt@raderfishman.com>  
Cc: "Ronald P. Kananen" <rpk@raderfishman.com>  
Subject: Re: DC107977.XLS  
<<Sony Updated DC107977 030109.XLS>> <<Results on 100 cases 030109.XLS>>  
Dear Paula-san,

6/29/2006

Thank you for your study of the 100 cases.  
Please refer to 'Sony's Comment' in 'Results on 100 cases 030109.XLS'.  
The only cases that we need further search are listed in the below Sheet D.

According to the comments on the above-mentioned file,  
We updated the listings; 'Sony Updated DC107977 030109.XLS'.

Sheet A: Matched 1991 cases. They are identified with application number.  
We will transfer the responsibility from your office to  
Computer Packages Inc.

Sheet B: Matched 143 cases. They are not identified with application number.  
They will be transferred to CPI when you inform us of the  
application number and filing date.

Sheet C: Matched 24 cases. They are joint-applicant cases.  
Please continue to manage the annuity payment through our  
Japanese associates.

Sheet D: Missing 18 cases from RFG listing.  
We will continue to search.  
Please let us know your comment on the cases respectively.

Please note that [REDACTED] are  
listed in Sheet D., [REDACTED] is in Sheet A.  
We confirm [REDACTED] is abandoned, so it is not listed.

Regarding the cases in the Sheet A, we will transfer the responsibility for  
the maintenance fee payment of the cases that are still payable from your  
office to Computer Packages inc. (CPI), and ask them if they can start with  
the cases due in February 2003.

So please hold your payment until you receive our further instruction.  
Until when do you wish to have the payment instruction from us?

Best Regards,

Sanae Takada  
Sony Techno Research Corporation

Attachment Files

1. Results on 100 cases 030109.XLS
2. Sony Updated DC107977 030109.XLS

---

In message "DC107977.XLS",  
Paula L. Talarek wrote...  
From: "Paula L. Talarek" <plt@raderfishman.com>  
To: "Sanae Takada@jp.sony.com" <Sanae.Takada@jp.sony.com>

6/29/2006

Cc: "Ronald P. Kananen" <rpk@raderfishman.com>

Subject: DC107977.XLS

Date: Mon, 16 Dec 2002 17:37:38 -0500

>Dear Sanae-san:

>

>Here is the marked up Excel sheet with the 100 cases. Please note that

>we are trying to locate some of the older cases for insertion of the RFR

>reference number. We are having difficulty locating the proper cases

>for [REDACTED]; [REDACTED]; [REDACTED]; [REDACTED]; [REDACTED]

>[REDACTED] If you could give us additional information it would be

>appreciated.

>

>Best regards,

>Paula Talarek

>

————— このメールにはファイルが添付されています —————

Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT D**

A: Sony - RFG matched cases (In Force)

(The cases are assigned with serial application number.)

As of Jan. 10, 2003									
SONY REF.	RFG REF.	SERIAL NO.	FILING DATE	PUBL	PATENT NO.	ISSUE	TITLE	STATUS	EXPIRATION
914 S93P0482US01	80001-0438	08/736, 288	10/24/1996				SON-906/REISSUE INPUT AP	PENDING	10/24/2016

Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT E**





PAYOR NUMBER  
1841

RONALD P. KANANEN  
RADER, FISHMAN & GRAUER  
1233 20TH STREET, NW  
SUITE 501  
WASHINGTON, DC 20036

P75M

DATE PRINTED

04/16/03

Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
Washington, DC 20231  
www.uspto.gov

### MAINTENANCE FEE REMINDER

According to the records of the Patent and Trademark Office the maintenance fee for the Patent(s) listed below, for which the above address is of record as the fee address under CFR 1.363 has not been paid within the six-month period set forth in 37 CFR 1.362(D). THE MAINTENANCE FEE MAY STILL BE PAID WITH THE APPLICABLE SURCHARGE SET FORTH IN 37 CFR 1.20(H), WITHIN THE SIX-MONTH GRACE PERIOD SET FORTH IN 37 CFR 1.362(e).

Each patent for which the applicable maintenance fee is not paid to the Patent and Trademark Office on or before the date the fee is due or within the grace period, accompanied with the applicable surcharge if paid within the grace period, WILL EXPIRE AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b).

A PATENT EXPIRES AT THE END OF THE SAME DATE (ANNIVERSARY DATE) THE PATENT WAS GRANTED IN THE 4TH, 8TH, OR 12TH YEAR AFTER THE GRANT DEPENDING ON THE MAINTENANCE FEE WAS NOT PAID. 37 CFR 1.362(g).

THE PAYMENT DUE AS SET FORTH BELOW IS BASED ON THE SMALL ENTITY STATUS ACCORDING TO CURRENT OFFICE RECORDS.

TIMELY PAYMENT OF THE TOTAL FEE DUE IS REQUIRED IN ORDER TO AVOID EXPIRATION OF THE PATENT. NOTE 37 CFR 1.378.

PATENT NUMBER	MNT FEE	SUR CHG	U.S. APPL NUMBER	PATENT DATE	APPLI- CATION FILE DATE	PAY- MENT YEAR	SMALL ENT- ITY ?	TOTL PAYM DUE	ATTORNEY DOCKET NUMBER
5453758	2050	130	08098896	09/26/95	07/29/93	8	NO	2180	SON417
	2050	130				8	NO	2180	

DIRECT THE RESPONSE TOGETHER WITH A COPY OF THIS NOTICE, AND ANY QUESTIONS ABOUT THIS NOTICE TO:  
DIRECTOR OF PATENTS AND TRADEMARKS, BOX M. CORRESPONDENCE, WASHINGTON, DC 20231

Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT F**

In re Egbers (ComrPats) 6 USPQ2d 1869

**In re Egbers**

**U.S. Patent and Trademark Office Commissioner of Patents  
6 USPQ2d 1869**

**Decided April 7, 1988  
Control No. 90/000,792**

**Headnotes**

**PATENTS**

**1. Practice and procedure in U.S. Patent and Trademark Office -- Re-examination --  
Rules and rules practice (§ 110.1503)**

Re-examination proceeding which has been terminated due to late response to PTO action may be revived by commissioner if delay was "unavoidable" as contemplated by 35 USC 133, which provides sole basis for reviving terminated re-examination proceeding, and such terminated proceeding may not be revived for "unintentional" delay under 35 USC 41 (a)(7), nor will

petitions to revive terminated re-examination proceedings be considered under "extraordinary situation, where justice requires" standard of 37 CFR 1.183

**2. Practice and procedure in U.S. Patent and Trademark Office -- Re-examination -- Rules and rules practice (§ 110.1503)**

Reasonable misinterpretation of regulation may constitute "unavoidable" delay as contemplated by 35 USC 133, but misapplication or total ignorance of rule does not, nor does counsel's unawareness of PTO rules and procedures.

**3. Practice and procedure in U.S. Patent and Trademark Office -- Re-examination -- Rules and rules practice (§ 110.1503)**

Delay in responding to PTO action due to errors in counsel's docketing system is not "unavoidable," in view of petitioner's failure to show that such system was highly reliable or that docketing errors were cause of belated response.

**Case History and Disposition:**

Page 1869

Petition to revive and restore re-examination proceeding. On remand from U.S. District Court for the District of Columbia. Petition denied.

**Attorneys:**

Ellsworth H. Mosher, Alexandria, Va., for petitioner.

## Opinion Text

### Opinion By:

Quigg, commissioner of patents and trademarks.

### A. Background

Egbers et al.'s multiple petition entitled "Petition Under 37 CFR §1.137(b) To Revive and Restore To Active Status a Re-examination Proceeding 'Unintentionally Abandoned' and Petition Under 37 CFR §1.137(a) To Revive and Restore To Active Status a Re-examination Proceeding 'Unavoidably Abandoned' Combined with Petition Under 37 CFR §1.183 To Suspend the Rules So As To Enable the Commissioner To Grant the Relief Requested" (hereinafter "the petition"), filed August 24, 1987, is before the Commissioner pursuant to a remand from the District Court for the District of Columbia in *Theodor Groz & Ernst Bechert Nadelfabrik KG v. Quigg*, Civil Action No. 87-1340 (D.D.C.). Rather than repeating the facts in this new petition, petitioner refers to previously filed papers, including its September 12, 1986, and January 21, 1987, petitions.

The facts leading up to the civil action are as follows:

On July 16, 1985, the PTO granted petitioner's (the patent owner's) request, filed June 3, 1985, for reexamination of its U.S. Patent No. 4,452,053.

A first Office action on the merits was mailed October 23, 1985, setting a two-month period for response. After obtaining a one month extension of time, petitioner filed a timely response on January 24, 1986.

A second Office action, finally rejecting claims 1-17 under 35 U.S.C. §103 and setting a two-month period for response, was mailed on April 15, 1986.

On May 14, 1986, an interview was conducted between the examiner and petitioner's representatives, but no agreement was reached.

On June 16, 1986 (certificate of mailing date: June 13, 1986), previous counsel for petitioner submitted a thirty-two page response to the final Office action and a confirmation of the May 14

interview. At page 23 of the response, last paragraph, petitioner said that it "will shortly submit two additional declaration[s] . . . by engineers from Terrot, of Stuttgart, and Meyer and Cie., of Tailfingen, both of the Fed. Rep Germany." In a footnote at the same page, it was stated that a petition for a one-month extension of time, with fee, was filed with the response "to provide time for obtaining consideration of those declarations." Accordingly, the response was accompanied by a "Petition for Extension of Time," wherein petitioner requested a one month extension of time until July 15, 1987, and a check for \$56.

On June 25, 1986, the petition for an extension of time was dismissed by the group director because it apparently was filed un

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der 37 C.F.R. §1.136, which does not apply to reexaminations. *See* Manual of Patent Examining Procedure (MPEP) §2265. However, petitioner was advised that since the first timely response to a final Office action in a reexamination proceeding is considered a request for a one month extension of time, the due date for a response to the April 14 Office action was extended to July 15, 1986. Petitioner was also reminded that extensions of time in reexaminations are governed by 37 C.F.R. §1.550(c). This section states that a request for an extension of time in a reexamination proceeding must be filed on or before the due date for a response and that it will be granted only for sufficient cause and for a reasonable time.

On July 14, 1986 (certificate of mailing date: July 10, 1987), petitioner timely filed a five page supplementary response including two declarations.

However, in an advisory Office action mailed July 23, 1986, the petitioner was advised by the examiner that the response did not overcome the final rejection. This advisory action when mailed did not include a mailing date and did not indicate the number of months in the period for response to the April 14 Office action.

Petitioner filed a petition for extension of time with a notice of appeal on August 5, 1986 (certificate of mailing date: July 30, 1986).

On September 4, 1986, the petition for an extension of time was dismissed as untimely, the response period having already expired. On September 8, 1986, the PTO mailed petitioner a "Notice of Intent to Issue Reexamination Certificate" for failure to file a timely notice of appeal. On September 19, 1986 (certificate of mailing date: September 12, 1986), petitioner filed a

petition under 37 C.F.R. §1.183 (Rule 183) seeking to have the Commissioner waive 37 C.F.R. §§1.550(c) or (d) so as to have the late notice of appeal treated as though timely filed. This petition was denied on October 9, 1986.

On December 16, 1986, Reexamination Certificate No. B1 4,452,053 issued, cancelling claims 1-17, all the claims in the patent.

On January 21, 1987, petitioner (now represented by present counsel) filed a combined petition to rescind the reexamination certificate and to accept the notice of appeal as timely filed.

Petitioner supplemented this petition on January 23 with an additional affidavit and on February 26 with a terminal disclaimer.

This petition was denied on February 25, 1987. A petition for reconsideration, filed March 12, 1987, was denied on May 1, 1987.

The above-identified civil action was filed on May 19, 1987. The petition which is now before the Commissioner was filed in the PTO on August 24, 1987, and raised for the first time the question of whether a reexamination proceeding which was terminated due to a late response to an Office action may be revived if the delay in responding was either "unavoidable" or "unintentional."

On August 24, 1987, the Commissioner moved for remand of the case to the PTO for consideration of this new argument. This motion was granted by the Court on August 31, 1987.

***B. Petitioner's Notice of Appeal was filed after the end of the period set for response to the final Office action***

Petitioner's argument that the reexamination proceeding was improperly terminated because there in fact was no hiatus between the end of the response period and the filing of the Notice of Appeal is without merit. In his June 25 decision denying the petition for a one month extension of time which accompanied the incomplete June 16, 1986, response, the director, after noting that petitioner was entitled to an automatic one month extension of time, clearly stated that July 15 was the due date for a response to the April 15, 1986, final Office action (emphasis added):

The petition is Dismissed, *the time for response is set to expire July 15, 1986*, and the reexamination file is remanded to the examiner for prompt consideration of the June 16, 1986, response.

Thus, there was no reason to assume, as petitioner now contends it did, that the automatic one month extension was set to *begin* on July 15 (see Aug. 24, 1987, petition, at 21-22).

Furthermore, while the July 23, 1986, advisory action may have been undated and may have omitted a statement of the period for response to the final Office action, nothing in the advisory action changed the clear language of the director's decision concerning the due date for a response.

Petitioner also argues that under 37 C.F.R. §1.550(b), which states that a patent owner will be given at least thirty days to respond to any Office action, petitioner had at least thirty days from the July 23 advisory action in which to respond further, which it did by filing a Notice of Appeal. The fallacy in this argument is its treatment of an advisory action as though it is an "Office action" in the sense of §1.550(b). Section 1.116(a), which governs "after final" practice in reexamination proceedings as well as in other proceedings, states in pertinent part:

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The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal.

*See also* MPEP §2272 ("Consideration of amendments submitted after final rejection [in a reexamination proceeding] will be governed by the strict standards of 37 CFR 1.116").

Accordingly, the examiner's admissions into the record of the supplemental amendment, including the missing declarations, did not relieve the patent owner from the requirement to file an appropriate response to the April 15, 1986, final Office action (such as a notice of appeal) or to obtain an extension of time pursuant to §1.550(c). Absent such a response, the reexamination proceeding was properly terminated on July 16, 1986, the day after a response was due. 37 C.F.R. 1.550(d). The advisory action, mailed July 23, 1987, could not and did not begin a new period for response. *See Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985) (advisory action does not mark the beginning of a new response period). Thus, the notice of appeal, filed July 30, 1986, was not filed within the period set for response.

***C. A terminated reexamination proceeding may be revived for "unavoidable" delay under 35 U.S.C. §§305 and 133, but not for***



**"unintentional" delay under §41(a)(7)**

[1] For the reasons set forth in *In re Katrapat, AG*, 6 USPQ2d 1863 (Comm'r Pat. 1988), the Commissioner agrees with petitioner that under 35 U.S.C. §§305 and 133 considered together, the Commissioner may revive a reexamination proceeding which has been terminated due to a late response to an Office action, provided the delay was "unavoidable" in the sense of §133. Moreover, as explained in *Katrapat*, §133 provides the sole basis for reviving a terminated reexamination proceeding. A terminated reexamination proceeding may not be revived for "unintentional" delay under §41(a)(7). Furthermore, petitions to revive terminated reexamination proceedings will no longer be considered under the "extraordinary situation, where justice requires" standard of 37 C.F.R. §1.183.

Therefore, to the extent petitioner seeks relief under 37 C.F.R. §1.137(a) and (b) and under §1.183, the petition is denied. The petition therefore will be considered as though it had been filed under 35 U.S.C. §133.

**D. Petitioner has not demonstrated that the delay was "unavoidable" in the sense of §133**

As discussed in *Katrapat*, *supra*, the term "unavoidable delay" in the context of reexaminations proceedings has the same meaning it has with respect to abandonment in patent application proceedings:

is applicable to ordinary human affairs, and requires no more or greater care than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

*Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887); *In re Matullath*, 38 App. D.C. 497, 514-15 (1912); *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), *aff'd*, 143 USPQ 172, 172 (D.C. Cir. 1964). *See also Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913) (delay in responding to Office action due to docketing error held unavoidable in view of counsel's elaborate record system for keeping track

of pending applications and employment of all reasonable checks that could be required for preventing such errors); *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982) (delay held not unavoidable, because (1) Smith's excuses contained conflicting statements, (2) preoccupation of Smith's attorney with other legal matters or moving his residence did not relieve Smith of complying with PTO regulations, and (3) Smith's attorney was aware of the due date for response and thus had sufficient time to take action to avoid abandonment).

[2] Furthermore, while a reasonable misinterpretation of a regulation may be the basis for a holding of unavoidable delay, *In re Decision Dated February 18, 1969*, 162 USPQ 383 (Comm'r Pat. 1969), misapplication or total ignorance of a rule may not. See *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985) (counsel's misapplication of certified mailing rule does not constitute unavoidable delay); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978) (Markey, C.J., sitting by designation) (counsel's total unawareness of applicable rules is not a basis for finding unavoidable delay).

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In the new petition, petitioner argues that if its notice of appeal is considered to have been late, then its failure to file it prior to July 15, 1986, was due to an ambiguity in the due date for a response to the April 15, 1986, Office action and to errors in the previous counsel's docketing system.

As noted above, there was no ambiguity in the due date for a response to the final Office action; it was clearly set by the director to be July 15, 1986.

[3] As for the alleged docketing errors, in order to be entitled to relief under 35 U.S.C. §§305 and 133 on this ground, petitioner must show (1) that its counsel was justified in relying on the docketing system, i.e., that the docketing system was highly reliable, and (2) that the docketing errors were the cause of the belated response. Petitioner has shown neither.

In contrast to *Katrapat*, this is not a case where a trustworthy employee, using a highly reliable docketing system, omitted a single critical docket entry whose omission resulted in a late response to an Office action.

Evidence of the unreliability of petitioner's previous counsel's docketing system is apparent from

the exhibits which accompanied the September 15, 1986, petition, filed by previous counsel. In fact, petitioner concedes that there were several docketing lapses with respect to the Egbers reexamination. ( See petition received Sept. 15, 1986, at 9-10.) Exhibit A is a copy of counsel's docket report for June 15, 1986, the original due date for a response to the final rejection. As acknowledged at pages 9-10 of that petition, the entries in this report show a lapse in docketing procedure with respect to the Egbers reexamination in that the report fails to note (a) that the June 13 response was accompanied by a request for an extension of time and (b) that the Office action was "final." In contrast, the entry for another reexamination (Monarch) includes a notation that the Office action is final. Exhibit B, the secretary's notes for April 15, 1986, from which the docket report shown in Exhibit A was prepared, fails to indicate that the Office action in the Egbers reexamination is final, whereas it does indicate that the Office action in the Monarch reexamination is final. As for Exhibit C, which is counsel's docket report for the period covering June 1 to 15, the "final date" for the Egbers reexamination is given as June 15, and the "date completed" is given as June 13, even though the response filed on that date was incomplete, since the declarations were not included. Exhibit D, counsel's docket report for the period July 1-15, 1986, correctly indicates that the "final date" for the Egbers case is July 15, apparently taking into account the additional month automatically received when the June 13 response was filed, as noted in the Director's decision of June 25, 1986. This docket report also correctly indicates that declarations are due July 15. However, this report fails to indicate that Egbers is a reexamination proceeding.

Exhibit E, which is a copy of counsel's docket report for July 15, 1986, indicates that a response was filed in "Egbers" on July 10, but fails to note that Egbers is a reexamination and that the outstanding Office action is final. More important, this docket report does not indicate a need to inquire as to the status of the reexamination prior to July 15 or to take further action by that date, so as to avoid termination of the reexamination.

Thus, instead of demonstrating that petitioner's previous counsel had a highly reliable and trustworthy docketing system, petitioner has shown that there were numerous omissions from the data recorded in that system with respect to the Egbers reexamination proceeding. Consequently, petitioner's previous counsel was not justified in relying solely on this docketing system for information about the Egbers reexamination proceeding. For this reason alone, the omission of this data cannot serve as the basis for a holding that the delay in responding was unavoidable in the sense of §133.

Furthermore, while, some docketing lapses clearly did occur with respect to the Egbers reexamination, these lapses were not the sole cause of the failure to file a timely response to the April 15, 1988, Office action.

It must be presumed that when previous counsel prepared the supplemental response filed July 10, he reviewed the file sufficiently to know that he was responding to a final Office action in the Egbers reexamination proceeding. At this time he could and perhaps should have noted on the July 15 docket report that further action (such as obtaining an extension of time or filing a notice of appeal) was due by July 15 in order to avoid termination of the proceeding in the event the examiner held the June 13 and July 10 responses insufficient to overcome the final rejection. However, counsel did not do so. The reason appears to be that counsel was unaware that the failure to take further action prior to July 15 could result in termination of the reexamination. As stated by previous counsel in the September 15, 1986, petition at page 6:

When the long-awaited declarations finally arrived, they were promptly provided [to the PTO] with an explanatory letter and mailed on July 10, 1986, *without*

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*realization* that the likelihood of receiving an Official Action in time for consideration before the time for further response ran out had so greatly diminished *that the time had come to petition for further extension of time for a length of time, perhaps a month and at least two weeks, of [sic, from?] an expected Advisory Action before deciding to appeal* .

The question was not raised, as it should have been, on the 15th, by the docketing system of the attorney's office *because of the unfamiliarity with final rejections in re-examination proceedings* . It was not therefore until the undated Advisory Action, entering the submitted documents and letting the final rejection stand, was received on July 25, 1986, that the fact and significance of these oversights were realized by the attorneys.

In view of the above, it is clear that the failure to take further action by July 15 was due at least in part to counsel's misunderstanding of "after final" practice in reexamination proceedings. It is well settled that counsel's unawareness of PTO rules and procedures does not constitute "unavoidable" delay. *See Vincent v. Mossinghoff, supra; Potter v. Dann, supra* . For all of the above reasons, the petition is *denied* .

### **E. Summary**

The August 24, 1987, petition to revive the reexamination proceeding on the grounds that the appeal brief was actually timely filed and that, even if not timely filed, the delay in filing the appeal brief was "unavoidable" or "unintentional" is denied. Likewise, to the extent the petition requests relief under 37 C.F.R. §1.183, it is denied.

- End of Case -

Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT G**

**SONY**

Intellectual Property Department, Sony Corporation  
Gate City Osaka 1-11-1 Osaka, Shinagawa-ku, Tokyo, 141-0032 Japan

Telephone: +81-3-5435-3910  
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BY FACSIMILE  
ORIGINAL BY AIR MAIL

June 26, 2006

Ronald P. Kananen, Esq  
Rader, Fishman & Grauer  
1238 20th Street, N.W.  
Washington, D.C. 20036  
U.S.A.

**IMPORTANT NOTICE**

Re: Response to Show Cause Order of May 31, 2006 due June 30, 2006

US Patent No.	: Reissue of US Patent No. 5453758
Ser. No.	: 08/786288, filed October 24, 1996
Your Ref.	: SON-906/REISSUE, 80000.488
Sony Ref.	: S93P0482US01
Assignee	: Sony Corporation

Dear Ronald P. Kananen, Esq

Thank you very much for your letter dated June 16, 2006, resent to me on June 22, 2006.  
I would like to report you about what I found.

Initial Delay

By our present procedure for managing reissue patents in our docketing system, a status code "07" = withdrawal should be input to a parent patent after a reissue patent application grants. Our docketing system record shows that the status code "07" was input to the '758 patent on May 6, 1998. On the same day, a status code "01" = filed was input to the application for reissue for the '758 patent.

There was not a written manual for managing reissue cases in our section at that time. (Our present written manual was made in July 1999.) So I assume that an inexperienced clerk might input the status code "07" = withdrawal to the '758 patent by error although the application for reissue of the '758 was still pending.

When we made a list of cases to transfer the renewal management from your firm to CPI, we deleted cases having status code "07" = withdrawal. Therefore, we did not transfer the '758 patent to CPI. In the meantime, we transfer the application for reissue for the '758 patent to CPI, however, we did not input CPI the parent patent's information. CPI could not pay the 7.5 year maintenance fee in time.

We can not find records whether we received a maintenance fee reminder of 7.5 year for the '758 patent from your firm or not. And we can not find records whether we received an official maintenance fee reminder from USPTO or not.

**Subsequent Delay**

We did not know the fact that the 7.5 year maintenance fee for '758 patent was not paid until your firm sent us your letter dated June 8, 2006.

If you have any questions or suggestions, please do not hesitate to contact us.

Sincerely yours,



Sanae Takada  
Assistant Manager  
Foreign Patent Affairs Gp.  
Intellectual Property Control Dept.  
Sony Intellectual Property Solutions Corporation



Application No: 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT H**

In re Katrapat, AG (ComrPats) 6 USPQ2d 1863

**In re Katrapat, AG**

**U.S. Patent and Trademark Office Commissioner of Patents  
6 USPQ2d 1863**

**Decided April 6, 1988  
Control No. 90/000,900**

**Headnotes**

**PATENTS**

**1. Practice and procedure in U.S. Patent and Trademark Office -- Re-examination --  
Rules and rules practice (§ 110.1503)**

Late responses to PTO actions in re-examination proceedings should be judged by "unavoidable delay" standard, since intent of 35 USC 305, which governs re-examination procedure generally, is that such proceeding must be terminated unless delayed response is shown to be "unavoidable" within meaning of 35 USC 133, which governs abandonment of patent applications.

**2. Practice and procedure in U.S. Patent and Trademark Office -- Re-examination -- Rules and rules practice (§ 110.1503)**

Delay in filing response to office action in re-examination proceeding is "unavoidable" within meaning of 35 USC 133 if delay is due to unexpected or unforeseen failure in agency or instrumentality ordinarily relied upon by prudent and careful person in carrying out important business, but delay resulting from misapplication or total ignorance of PTO regulation is not "unavoidable."

**3. Practice and procedure in U.S. Patent and Trademark Office -- Re-examination -- Rules and rules practice (§ 110.1503)**

Petition to revive terminated re-examination proceeding may properly be filed under 35 USC 133, but filing such petition under 37 CFR 1.137(a) is improper since that regulation is limited to revival of patent applications, and filing revival petition under 37 CFR 1.183, which provides for suspension of regulations, but not statutory requirements, in extraordinary situations, is also improper since "unavoidable delay" standard of 35 USC 133, permitting revival of re-examination proceedings, is statutory rather than regulatory.

**4. Practice and procedure in U.S. Patent and Trademark Office -- Re-examination -- Rules and rules practice (§ 110.1503)**

Re-examination proceeding that has been "unintentionally" terminated due to untimely-filed response may not be revived pursuant to 35 USC 41(a)(7) and 37 CFR 1.137(b), since statute and regulation are intended to apply only to unintentionally abandoned patent applications, and since allowing revival as late as one year after termination under 37 CFR 1.137(b) would be inconsistent with requirement of 35 USC 305 that re-examination proceedings be conducted with "special dispatch."

**5. Practice and procedure in U.S. Patent and Trademark Office -- Re-examination --  
Rules and rules practice (§ 110.1503)**

Late filing of response to PTO action in re-examination proceeding due to counsel's reliance on incorrect docket report was "unavoidable" within meaning of 35 USC 133, since reliance on docket report was reasonable in view of the otherwise high reliability of such reports and absence of evidence that counsel should have employed additional safeguards or expected errors in docket reports, and since counsel was diligent in preparing prompt response after docketing error was discovered.

**Case History and Disposition:**

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Petition of Katrapat, AG, to revive terminated re-examination proceeding, control no. 90/000,900, and for board review of rejection of claims 1-4 of patent no. 3,957,084. On remand from the U.S. District Court for the District of Columbia. Petition to revive is granted in part and denied in part, and request for review of rejection of claims is dismissed as premature.

**Attorneys:**

Michael L. Keller and Cushman, Darby & Cushman, Washington, D.C., and Thomas W. Ehrmann, Robert L. Titley, Susan LaCava, and Quarles & Brady, Milwaukee, Wis., for petitioner.

## Opinion Text

### Opinion By:

Quigg, commissioner of patents and trademarks.

### A. Background

Katrapat's "Petition to Revive a Reexamination Proceeding or, in the Alternative, for Board Review of the Examiner's Rejection of Claims 1-4 of the Patent," filed on December 14, 1987, is currently before the Commissioner for consideration on the merits pursuant to an October 29, 1987, remand order in *Katrapat, A.G. v. Quigg*, Civil Action No. 87-0250-LFO (D.D.C.). The proceedings in the Patent and Trademark Office (PTO) which led up to the civil action are briefly as follows.

On January 23, 1986, the PTO granted a request filed by Advance Machine and Engineering Company ("Advance") for reexamination of Katrapat's U.S. Patent No. 3,957,084 ("the '084 patent"). A patent owner's statement was received from Katrapat on March 27, 1986, and on May 29, 1986, the PTO received a reply from Advance.

On June 18, 1986, an examiner mailed a non-final first Office action in which the patentability of the subject matter of claims 5-16 of the '084 patent was confirmed and claims 1-4 were rejected under 35 U.S.C §102(a) as anticipated by prior art cited in the reexamination request. The examiner set a shortened statutory period of two months for Katrapat's response to the Office action, making a response due by August 18, 1986.

A response was not received by the PTO until August 29, 1986, when the PTO received an amendment wherein Katrapat proposed to add claims 17 and 18 to the '084 patent and argued that these new claims as well as original claims 1-4 are not anticipated by the prior art. This response bears an "Express Mail" date of August 28, 1986, which means that the response was ten days late. The response was accompanied by a "Petition to Waive the Rules Pursuant to 37 C.F.R. 1.183," wherein Katrapat requested a waiver of the rules so that its late response could be treated as though it had been filed on time. Supporting affidavits were provided by Katrapat's counsel in the reexamination proceeding and the records clerk whose docketing error allegedly caused the delay in responding to the June 18, 1986, Office action.

In a decision dated October 21, 1986, the Assistant Commissioner for Patents denied the above petition on the ground that although Katrapat had shown that the delay in filing the response was due to a docketing error which occurred when counsel's law firm was being readied for relocation, such an error does not constitute an "extraordinary situation" requiring relief under §1.183.

On October 23, 1986, the PTO notified Katrapat that the reexamination proceeding was considered terminated and that a certificate would issue. *See* 37 C.F.R. §1.550(d). On November 4, 1986, Katrapat requested reconsideration of the Assistant Commissioner's initial decision, which request was denied on December 3, 1986.

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On February 2, 1987, Katrapat filed a "Notice of Appeal" to the Board of Patent Appeals and Interferences (board) on the theory that the rejection of claims 1-4 became "final" when Katrapat's request for reconsideration was denied. The "Notice of Appeal" was accompanied by a "Petition to the Commissioner of Patents and Trademarks Under Rule 1.183," wherein Katrapat requested that the Commissioner suspend the rules relating to appeals and hold the appeal in abeyance pending a judgment in a civil action (the above-identified civil action), which was being filed that same day.

On February 10, 1987, reexamination certificate No. B1 3,957,084 was issued, in which the patentability of claims 5-16 was confirmed and claims 1-4 were cancelled.

Katrapat's February 2, 1987, petition was dismissed by the Assistant Commissioner in a decision dated February 26, 1987, on the grounds that (1) the denial of Katrapat's request for reconsideration did not make the June 18, 1986, Office action "final" for the purpose of appeal to the board and (2) the reexamination proceeding was terminated on February 10, 1987, when the reexamination certificate issued.

During the course of the civil action, Katrapat filed a motion for summary judgment in which it alleged for the first time that MPEP §2268 is invalid insofar as it requires that petitions concerning late responses in reexamination proceedings be filed under 37 C.F.R. §1.183, which permits the Commissioner to waive or suspend rules in an "extraordinary situation, where justice requires." In Katrapat's view, a reexamination proceeding which has been terminated because a

response to an Office action was late should be revivable under the same conditions which permit an abandoned application to be revived, i.e., if the delay can be shown to have been either "unavoidable" or "unintentional."

Because Katrapat had not made this argument previously in the PTO, the Commissioner moved for a remand of the case to the PTO for consideration of a new petition directed to this argument. The motion for remand was granted on October 29, 1987, and on December 14, 1987, Katrapat filed the petition currently under consideration. In this new petition, Katrapat requests that the Commissioner revive the reexamination proceeding either under 35 U.S.C. §§305 and 133 and 37 C.F.R. §1.137(a) on the ground that the delay in filing the response was "unavoidable" or alternatively under Pub. L. 97-247, §3(a)(7) (codified at 35 U.S.C. §41(1)(7) ), and 37 C.F.R. §1.137(b) on the ground that the delay was "unintentional." Furthermore, in the event the Commissioner should deny the request to revive the reexamination proceeding, Katrapat requests board review of the examiner's rejection of claims 1-4.

**B. A terminated reexamination proceeding may be revived for "unavoidable" delay under §133, but not for "unintentional" delay under §41(a)(7 )**

In its new petition, Katrapat argues that MPEP §2286, which states that petitions regarding late responses in reexamination proceedings shall be filed under 37 C.F.R. §1.183, is contrary to 35 U.S.C. §305, which provides that

fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. . . .

In this regard, Katrapat also cites 1980 U.S. Code Cong. & Admin. News 6460, 6466 ("Section 305 specifies that after the initial exchange permitted under section 304, the PTO will utilize the same procedures it uses for initial examination of patent applications under patent law sections 132 and 133").

35 U.S.C. §133 reads as follows (emphasis added):

*Upon the failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be*

*regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable .*

[1] While §133 cannot literally be applied to a reexamination proceeding, inasmuch as a reexamination proceeding does not involve an "application," the Commissioner agrees with Katrapat that late responses to Office actions in reexamination proceedings should be judged by the "unavoidable delay" standard. The reason is that Congress, by expressly referring to §133 in §305 of the reexamination statute, apparently intended that termination of reexamination proceedings be *analogous* to abandonment of patent application proceedings. That is, Congress intended that upon the failure of a patent owner to timely respond to an Office action in a reexamination proceeding, the proceeding must be terminated unless the delay in responding to the Office action can be shown to the satisfaction of the Commissioner to have been "unavoidable" in the sense of §133.

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[2] Moreover, it would appear that Congress intended that "unavoidable" in the context of reexamination proceedings have the same meaning it has with respect to abandonment in patent application proceedings:

is applicable to ordinary human affairs, and requires no more or greater care than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

*Ex parte Pratt* , 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887); *In re Matullath* , 38 App. D.C. 497, 514-15 (1912); *Winkler v. Ladd* , 221 F.Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), *aff'd* , 143 USPQ 172, 172 (D.C. Cir. 1964). *See also Ex parte Henrich* , 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913) (delay in responding to Office action due to docketing error held unavoidable in view of counsel's elaborate record system for keeping track of pending applications and employment of all reasonable checks that could be required for



preventing such errors); *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982) (delay held not unavoidable, because (1) Smith's excuses contained conflicting statements, (2) preoccupation of Smith's attorney with other legal matters or moving his residence did not relieve Smith of complying with PTO regulations, and (3) Smith's attorney was aware of the due date for response and thus had sufficient time to take action to avoid abandonment).

Furthermore, while a reasonable misinterpretation of a regulation may be the basis for a holding of unavoidable delay, *In re Decision Dated February 18, 1969*, 162 USPQ 383 (Comm'r Pat. 1969), misapplication or total ignorance of a rule may not. See *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985) (counsel's misapplication of certified mailing rule does not constitute unavoidable delay); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978) (Markey, C.J., sitting by designation) (counsel's total unawareness of applicable rules is not basis for finding unavoidable delay).

[3] It should be noted that while, for the foregoing reasons, a petition to revive a terminated reexamination proceeding on the ground of unavoidable delay is appropriately filed under 35 U.S.C. §133, filing such a petition under 37 C.F.R. §1.137(a) would be inappropriate, because §1.137(a) is limited to revival of an "application" and a reexamination proceeding does not involve an application.

Inasmuch as the "unavoidable delay" standard is statutory rather than merely regulatory, and because 37 C.F.R. §1.183 does not empower the Commissioner to waive statutory requirements, *Brenner v. Ebbert*, 398 F.2d 762, 764, 157 USPQ 609, 610 (D.C. Cir. 1968), petitions under §1.183 concerning untimely responses in reexamination proceedings henceforth will be dismissed as inappropriate. MPEP § 2268 will be amended in due course to provide that petitions concerning untimely responses in reexamination proceedings should be filed under 35 U.S.C. §133, not 37 C.F.R. §1.183.

[4] Katrapat alternatively argues that a reexamination proceeding which has been terminated due to an untimely response may be revived pursuant to Pub. L. 97-247, §3(a)(7) (codified at 35 U.S.C. §41(a)(7)) and 37 C.F.R. §1.137(b), which permit an "unintentionally" abandoned application to be revived by a petition, provided it is accompanied by the appropriate fee and the petition is filed within one year of the date of abandonment. Katrapat argues that because these statutory and regulatory provisions were adopted in 1982, two years after the adoption of the reexamination statute, Congress must have intended that they apply to terminated reexamination

proceedings as well as abandoned patent application proceedings. But Katrapat has not identified, nor is the Commissioner aware of, anything in the statute or the legislative history which supports this argument. In fact, this argument runs counter to the language of the above sections, which specifically provide for revival of only unintentionally abandoned *applications*. Had Congress intended to additionally permit revival of unintentionally terminated reexamination proceedings, it could have demonstrated such intent by amending §305 to specifically refer to 35 U.S.C. §41(a)(7) as well as to §133, but it did not do so. More important, permitting revival of unintentionally terminated reexamination proceedings under the conditions set forth in 37 C.F.R. §1.137(b), i.e., up to one year after abandonment, manifestly would be inconsistent with the statutory requirement for "spe

Page 1867

cial dispatch" in the conduct of reexamination proceedings. 35 U.S.C. §305.

**C. Katrapat has demonstrated that the delay was "unavoidable"**

Katrapat's new petition, which is accompanied by new supporting affidavits by counsel and the records clerk as well as an affidavit by the operations supervisor, includes the following explanation of why Katrapat's response was late:

... Katrapat's attorneys [utilize] a computerized docketing system to insure that responses are timely filed. All PTO mail is delivered to the Intellectual Property records clerk, who notes on the first sheet the date of receipt, the due date and the file number and enters this data in a hardcopy log. Once a month, the records clerk enters the data from the hardcopy log into the computer, which generates dockets for individual patent attorneys. These dockets cover a rolling two-month period. As soon as she has finished her monthly entry, the records clerk instructs the computer operator to copy the patent docket data set to tape. The data set is also copied to tape once a week during the weekly system backup and every two weeks, when the computer operator copies all data on the system to vault tapes. The vault tapes are stored in another building and would be used to restore the system if it were destroyed by fire or flood. Thus, in addition to the hardcopy log and the data sets stored on the computer, there are three backup copies of the patent data set on tape.

The June 18 Office Action was delivered to the records clerk[,], who entered the date of receipt

and the due date on the first sheet. The clerk, however, did not have a file number for the reexamination, a very unusual circumstance, and consequently, could not enter the matter into her hardcopy log. She left the Office Action with [counsel], the patent attorney responsible for Katrapat's file, to obtain a file number. During the last two weeks of June, a substantial amount of the record clerk's time was consumed with packing the Intellectual Property Group's files for the move to the firm's new offices over the Fourth of July weekend and she forgot that she had left the Office Action with [counsel]. Additionally, the computer and its terminals had been moved to the new building. Since the docket covers a two-month period, the records clerk, who was too pressed for time to go to the new offices to use the computer, did not enter her hardcopy data for June. If a matter required immediate attention, she personally notified the attorney and wrote the matter on his May docket sheet. The record clerk believes that if she had entered her data for June at the normal time, the last week in June, she probably would have remembered having left the Office Action with [counsel]. The Office Action was never entered into the docket system.

When [counsel] received the Office Action, he did not know that a missing file number meant that the document had not been entered into the computer. The action was packed for the move. Approximately one month later, [counsel] left town to attend the American Bar Association convention in New York. He returned to the Office August 14 and 15 and left for a one week vacation on August 16. Thus, he was out of the office when the Katrapat response came due. [Counsel], however, had reviewed his docket for several weeks prior to August 8 to insure that all responses that would come due while he was gone would be completed and mailed before he left. Because the Katrapat action was never entered into the docketing system, counsel did not prepare a timely response. When [counsel] returned to the office on August 25, he learned that the Office Action had been omitted from his docket and that the response was overdue. He put aside all other work and prepared a paper fully responsive to the Office Action. This response, dated August 28, 1986, [received by the PTO on August 29, 1986] accompanies this petition. From the above facts, it is clear that the omission from counsel's docket report of data concerning the need for a response to the June 18 Office action appears to have stemmed from the fact that the records clerk did not have a "file number" on hand for the June 18 Office action when she received it from the PTO. Referring to her new affidavit (¶¶ 3-4, 8), she states that although it was "very unusual" for her not to have a file number when an Office action arrived in a reexamination proceeding, she did not have a file number when the June 18 Office action was

received, that she "could not enter the data on [her] Reminder Sheet [hardcopy log]," that she took the action to counsel for the number, that counsel kept the action and did not return it to her with the number, and that "while packing for the move, it slipped [her] mind that counsel had the Katrapat Office Action and that [she] had not entered it on [her] Reminder Sheet."

Although the records clerk states that she could not enter the June 18 Office action data in her "Reminder Sheet" without a file number, no explanation has been offered as

Page 1868

to why she did not have the file number on hand or why she could not have entered the incomplete data in the hardcopy log, with the intention of completing the entry when she obtained the missing file number. Had she followed this procedure, the incomplete entry in the log probably would have served to remind her that counsel still had the file. Be that as it may, the determinative question is not whether the records clerk can be faulted for not having the file number on hand when the Office action arrived or for forgetting that counsel had the file, but whether counsel was justified in relying solely on his docket report, which was based on the data the records clerk had entered in her Reminder Sheet. In other words, the question is whether counsel's total reliance on his docket report met the standard of care "observed by prudent and careful men in relation to their most important business [, which] permits them in the exercise of this care to rely upon . . . reliable employees, and such other means and instrumentalities as are usually employed in such important business." *Pratt*, supra.

[5] The Commissioner is satisfied that under the facts of this case this reliance was wholly justified. According to counsel's new affidavit (¶6), with the sole exception of the omission in question, no omissions have occurred in his docket reports in over five years (of which about four years preceded that omission), during which time the same records clerk has been responsible for their preparation. In view of the demonstrated high reliability of the docket reports, it does not appear that counsel should have perceived any need to employ additional safeguards to ensure that all docketing data was entered, even during the period including the firm's relocation. In fact, while the disruption caused by the relocation arguably may have prevented the records clerk from discovering her error, there is no evidence that the relocation caused the error. More important, there is no evidence that counsel ought to have expected errors to occur in his docket reports as a result of the relocation. Thus, this is not a case in which a

belated response to an Office action was due to a defective docketing procedure or a misunderstanding of PTO reexamination procedures. *Compare In re Egbers*, 6 USPQ2d 1869 (Comm'r Pat. 1988).

In addition to showing that counsel's reliance on his docket report was entirely justified, Katrapat has also demonstrated that counsel was diligent in preparing a response after the docketing error was discovered. Hence, the "conditions of promptness in its rectification [are] present." *Pratt*, *supra*.

For the foregoing reasons, the Commissioner is satisfied that Katrapat's ten day delay in filing a response to the June 18, 1986, Office action was "unavoidable" in the sense of § 133.

Accordingly, Katrapat's petition to revive the reexamination proceedings under 35 U.S.C. §§305 and 133 is granted.

**D. Katrapat is not entitled to board review of the examiner's rejection of claims 1-4 at this time**

Katrapat also requests board review of the rejection of claims 1-4 in the event that its petition to revive this reexamination proceeding is denied. Since the Commissioner has granted the petition to revive, Katrapat's petition for board review of the rejection is dismissed as moot. In any case, even if the petition to revive had been denied, the petition for board review of the rejection would have been dismissed as premature, since the claims 1-4 have not been twice rejected or finally rejected in the reexamination proceeding, as is required for board review. 35 U.S.C. §§306 and 134.

**E. Conclusion**

Katrapat's petition to revive this reexamination proceeding pursuant to 35 U.S.C. §§305 and 133 on the ground that the delay in filing a response to the June 18, 1986, Office action was "unavoidable" is *granted*. However, to the extent the petition to revive the reexamination proceeding for "unavoidable" delay is based on 37 C.F.R. §137(a), it is *denied*, since that section is limited to revival of abandoned "applications."

Katrapat's alternative request to revive the reexamination proceeding under Pub. L. 97-247, §3(a)(7) (codified at 35 U.S.C. §41(a)(7)) and 37 C.F.R. §1.137(b) on the ground that the delay in filing a response to the June 18, 1986, Office action was "unintentional" is *denied*. Those sections are expressly limited to revival of unintentionally abandoned *applications* and Congress

has not indicated that it intended to establish an analogous procedure for terminated reexamination proceedings.

The request for board review of the rejection of claims 1-4 is *dismissed* as being premature.

The reexamination file is being returned to the examiner for consideration of the merits of Katrapat's August 29, 1987, response.

In view of the foregoing, Reexamination Certificate No. B1 3,957,084, published in the O.G. on February 10, 1987, is vacated and deemed null and void. A notice to this effect will be published forthwith in the Official Gazette.

**- End of Case -**

Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT I**

PAYOR NUMBER  
1841

P75M

RONALD P. KANANEN  
RADER, FISHMAN & GRAUER  
1233 20TH STREET, NW  
SUITE 501  
WASHINGTON, DC 20036

DATE PRINTED

10/29/03

## NOTICE OF PATENT EXPIRATION

According to the records of the Patent and Trademark Office, payment of the maintenance fee for the patents listed below has not been timely received prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b).

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(m) are paid, AND THE DELAY IN PAYMENT OF THE MAINTENANCE FEE IS SHOWN TO THE SATISFACTION OF THE DIRECTOR TO HAVE BEEN UNAVOIDABLE. 35 U.S.C. 41(c)(1).

IF THE COMMISSIONER ACCEPTS PAYMENT OF THE MAINTENANCE FEE UPON PETITION THE PATENT SHALL BE CONSIDERED AS NOT HAVING EXPIRED, BUT WOULD BE SUBJECT TO THE INTERVENING RIGHTS AND CONDITIONS SET FORTH IN 35 U.S.C. 41(c)(2).

NOTICE OF THE EXPIRATION WILL BE PUBLISHED IN THE OFFICIAL GAZETTE.

PATENT NUMBER	U.S. APPLICATION NUMBER	PATENT DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
5453758	08098896	09/26/95	07/29/93	09/26/03	



Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT J**

# Telephone Conference

Date: \_\_\_\_\_

File No.: \_\_\_\_\_

Who: \_\_\_\_\_

Phone No.: \_\_\_\_\_

Re: \_\_\_\_\_

5-24-65

D. Chow 571-272-7767

- Examiner says case is  
on his docket and is  
ready for ~~Examination~~ Examination.

~~There~~ Examiner says that there  
is nothing else that we  
need at this time.

9-9-65

- Examiner says case  
~~forwarded to SPRe~~  
allowed on Aug 19, 1965

~~On~~ - Examiner says  
case was forward  
to ~~SPRe~~ SPRe

- 9-9-65 BKO called  
SPRe Zele & left voicemail  
571-272-7286

9-12-65

Case for review  
with SPRe

Dwayne Boggs  
571-272-7023

Action Required: \_\_\_\_\_

Due: \_\_\_\_\_

**ATTACHMENT K**

Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT L**



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

Ronald P. Kananen  
Rader Fishman & Grauer  
1233 20<sup>th</sup> Street NW  
Suite 501  
Washington, DC 20036

In re Application of  
Kazuhiro Sato  
Application No. 08/736,288  
Filed: October 24, 1996  
Atty. Docket No.: SON-906/REIS

:  
: ORDER TO  
: SHOW CAUSE  
:  
:

MAILED  
MAY 31 2006  
REEXAM UNIT

This is a show cause order based on the expiration of U.S. patent 5,453,758, while the present application requests reissue of that patent.

**BACKGROUND**

1. The present application was filed October 24, 1996, for reissue of U.S. patent 5,453,758 (the '758 patent) issued September 26, 1995.
2. On November 23, 2004, a non-final Office action was mailed.
3. On January 24, 2005, a response to the November 23, 2004 Office action was filed.
4. The present reissue proceeding remains pending in Technology Center 2600.
5. Office financial records reveal that the 7.5 year maintenance fee due by February 26, 2003 and payable on or before September 26, 2003 (the end of the grace period), was not paid by September 27, 2003 (a Monday).
6. Office records reveal that the '758 patent has expired for failure to pay the 7.5 year maintenance fee. See 1276 *Official Gazette*, (November 25, 2003).

### ORDER TO SHOW CAUSE

As pointed out above, the present reissue proceeding is for reissue of the '758 patent, and that patent expired for failure to pay the 7.5 year maintenance fee. On November 25, 2003, a Notice of the expiration of the '758 patent was published in the *Official Gazette*. Since the '758 patent has expired for failure to pay the second maintenance fee, the Director of the USPTO no longer has the authority under 35 U.S.C. § 251 to reissue the '758 patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only "for the unexpired part of the term of the original patent." Thus, when *Morgan's* original patent expired on August 19, 1992, the Commissioner was divested of his reissue authority because there no longer was an unexpired term of the patent for which *Morgan's* patent could be reissued. *Morgan's* appeal thus became moot."  
[990 F.2d at 1231, 26 USPQ2d at 1393; Emphasis added]

Because the Director no longer has the authority under 35 U.S.C. § 251 to reissue the patent, the Office intends to terminate the present reissue proceeding, and thereafter hold the present application for reissue of the '758 patent to be an abandoned application.

Applicant is hereby being provided with a period of 30 DAYS from the mailing of this ORDER to show cause why the Office should not terminate the present reissue proceeding.

If applicant proposes to show cause why the present reissue proceeding should not be terminated, applicant's showing must include an explanation of why the proceeding should continue in spite of the expiration of the original patent.

If applicant makes a showing, the showing will be evaluated as to whether it provides sufficient reasons why the present reissue proceeding should not be terminated. A failure to present any reasons for not vacating these proceedings within the 30 day period will result in the proceedings being terminated by default. If the present reissue proceeding is terminated, the application for reissue of the '758 patent will be returned to Technology Center 2600 for processing as an abandoned application.

### CONCLUSION

1. Applicant is being provided with a period of 30 DAYS from the mailing of this ORDER to show cause why the Office should not terminate the present reissue proceeding.
2. Failure by applicant to respond to this show cause order within the 30 day period will result in termination of the proceeding by default, followed by a mailing of a Notice of Abandonment in the application for reissue of the '758 patent.
3. The file for reissue application 08/736,288 is an Image File Wrapper (IFW), an electronic file. A communication is being sent to Technology Center 2600 in the IFW system regarding the mailing of this Show Cause Order.
4. A copy of this Show Cause Order is being entered into the IFW.
5. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743 or, in his absence to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.



Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

sm  
May 31, 2006

**RADER,**

**FISHMAN**

**& GRAUER**

**PLLC**

Lion Building  
1233 20<sup>th</sup> Street N.W., Ste. 501  
Washington D.C. 20036  
Tel: (202) 955-3750  
Fax: (202) 955-3751

**Ronald P. Kananen**  
**(202) 955-3750**  
**rpk@raderfishman.com**

**By Facsimile; Confirmation by Air Mail**

June 8, 2006

Mr. Fumihiko Moriya  
Senior General Manager  
Intellectual Property Division  
Osaki East Technology Center  
Sony Corporation  
Gate City Osaki 1-11-1 Osaki, Shinagawa-ku  
Tokyo, 141-0032 Japan

Re: ***Response to Show Cause Order of May 31, 2006 due June 30, 2006***  
U.S. Reissue Patent Application of Kazuhiro SATO  
Serial No. 08/736,288; Filed: October 24, 1996  
(Reissue of U.S. Patent No. 5,453,758)  
For: "Input Apparatus"  
Sony Reference: S93P0482US01  
Our Reference: SON-906/REISSUE; Our File: 80000.438

Dear Mr. Moriya:

We have enclosed a copy of an Order to Show Cause why proceedings in this reissue application should not be terminated because of a failure to pay the maintenance fee for the issued patent, No. 5,453,758. No action had been taken in response to our amendment filed on January 24, 2005.

It seems that the 7 ½ year maintenance fee was due by February 26, 2003 and was not paid within the grace period expiring on September 27, 2003. Our current notice of maintenance fee management for which we have continued responsibility dated 2/21/06 is attached. Our files seem to indicate that CPI should have paid the maintenance fee for this case when originally due (see the attachment).

Please advise whether you will wish to try to reinstate these proceedings by



**RADER,**

**FISHMAN**

**& GRAUER**

**PLLC**

Mr. Fumihiko Moriya  
Sony Corporation  
June 8, 2006  
Page 2

petition to accept late payment of the maintenance fee, or whether you wished to abandon the patent thus terminating the reissue application as well.

We look forward to your clarification of this matter.

Very truly yours,  
**RADER, FISHMAN & GRAUER PLLC**

Ronald P. Kananen

RPK/bkd/tps

Enclosures: Order of May 31, 2006 to Show Cause

Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT M**

# SONY

# CONFIRMATION

Intellectual Property Department, Sony Corporation  
Gate City Osaki 1-11-1 Osaki, Shinagawa-ku, Tokyo, 141-0032 Japan

Telephone: +81-3-5435-3910  
Fax: +81-3-5435-3043

BY FACSIMILE  
ORIGINAL BY AIR MAIL

June 9, 2006

Ronald P. Kananen, Esq  
Rader, Fishman & Grauer  
1233 20th Street, N. W.  
Washington, D.C. 20036  
U.S.A.

Re: Response to Show Cause Order of May 31, 2006 due June 30, 2006

US Patent No.	: Reissue of US Patent No.5453758
Ser. No.	: 08/736288, filed October 24, 1996
Your Ref.	: SON-906/REISSUE, 80000.438
Sony Ref.	: S93P0482US01
Assignee	: Sony Corporation

Dear Mr. Ronald P. Kananen,

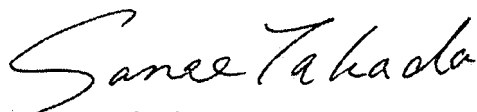
Thank you for your letter dated June 8, 2006.

It turned out that we failed to ask CPI to enter the parent patent 5453758 under their management. In other word, we did not include it in a list of transfer to CPI, or in a list which we would like you to handle by your office.

We wish to try to reinstate this case. If you need additional information or have any questions, please let us know.

As the document "Order to Show Cause" was not enclosed, we would like to ask you to send us a copy by fax.

Sincerely,



Sanae Takada  
Assistant Manager  
Foreign Patent Affairs Gp.  
Intellectual Property Control Dept.  
Sony Intellectual Property Solutions Corporation

Application No. 08/098,896  
Patent No. 5,453,758

Docket No.: SON-417

**ATTACHMENT N**

**RADER,**

**FISHMAN**

**& GRAUER**

**PLLC**

*Via Facsimile*  
011-81-3-5435-3043

Lion Building  
1233 20<sup>th</sup> Street N.W., Ste. 501  
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Tel: (202) 955-3750  
Fax: (202) 955-3751

**Ronald P. Kananen**  
**(202) 955-3750**  
**rpk@raderfishman.com**

June 16, 2006

Ms. Sanae Takada  
Assistant Manager  
Foreign Patent Affairs Group  
Intellectual Property Control Department  
Sony Intellectual Property Solutions Corporation  
Gate City Osaki 1-11-1 Osaki, Shinagawa-ku  
Tokyo, 141-0032  
JAPAN

Re: U.S. Reissue Patent Application of Kazuhiro SATO  
Serial No. 08/736,288; Filed: October 24, 1996  
(Reissue of U.S. Patent No. 5,453,758)  
For: "Input Apparatus"  
Sony Reference: S93P0482US01  
Our Reference: SON-906/REISSUE; Our File: 80000.438

Dear Ms. Takada:

Thank you for your letter of June 9, 2006 requesting our assistance in the reinstatement of U.S. Patent No. 5,453,758. As we had reported in our letter of June 8, 2006, the Order to Show Cause dated May 31, 2006 indicates the expiration of the above-identified patent. A copy of the Order to Show Cause is provided for your records and review.

Because a response to the Order to Show Cause is due by June 30, 2006, we ask for you input by **June 26, 2006**.

The website for the U.S. Patent and Trademark Office (USPTO) indicates that U.S. Patent No. 5,453,758, issuing from application Serial No. 08/098,896, became expired due to an alleged failure to pay the 7 ½ year maintenance fee by September 26, 2003.

In seeking the reinstatement of an expired patent, a Petition to the USPTO must show either an unavoidable delay or an unintentional delay in the payment of the maintenance fee due. As a result, we believe that the preparation and filing of this type of Petition should occur once a fact-intensive examination of the circumstances and reasons surrounding the delay in the payment of the maintenance fee due have been concluded.

Initial Delay - During its evaluation of the Petition, the USPTO will generally consider the circumstances and reasons surrounding the initial delay in paying the

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Bloomfield Hills

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Tokyo

**RADER,**

**FISHMAN**

**& GRAUER**

**PLLC**

Sony Corporation

June 16, 2006

Page 2

maintenance fee by to the due date of September 26, 2003, which resulted in the expiration of the patent.

Your letter indicates that neither we nor Computer Packages Inc. (CPI) had been instructed to handle the above-identified patent. Accordingly, please provide us with any detailed information regarding the circumstances and reasons surrounding this situation.

Subsequent Delay - The USPTO may also consider the circumstances and reasons surrounding the subsequent delay between the September 26, 2003 expiration date and the filing date of the Petition. In this regard, please provide us with any information regarding the circumstances and reasons surrounding the subsequent delay in the 7 ½ year maintenance fee payment from the time period after the patent had expired on September 26, 2003 through the date of your reply to this letter.


Course of Action - Since time is of the essence, please provide us with this information at your earliest convenience. Once this information has been received, the details surrounding the circumstances and reasons will be presented within a Petition for a review and decision by the USPTO.

If you have any questions regarding this matter, please do not hesitate to contact us.

Very truly yours,

**RADER, FISHMAN & GRAUER PLLC**



 Ronald P. Kananen

RPK/BKD/tps

Enclosure:     Order to Show Cause